



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/808,002

03/15/2001

Robert Stanley Arling

10010131-1

4587

24737

7590

10/24/2006

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

BLECK, CAROLYN M

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,002

Applicant(s)

ARLING ET AL.

Examiner

Carolyn M. Bleck

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 August 2006 has been entered.
2. This communication is in response to the RCE filed on 16 August 2006. Claims 1-3, 4-9, 11-16, and 18-23 are pending. Claims 1-2, 4-8, 15, and 23 have been amended. Claims 3, 10, and 17 have been cancelled.

Claim Rejections - 35 USC § 101

3. The rejection of claims 1-7 and 23 is hereby withdrawn due to the amendment filed on 16 August 2006.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3626

5. Claims 1-3, 4-9, 11-16, and 18-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 1 recites "wherein the characteristic is replaced with a calculation value derived from one or more measurements." The Examiner respectfully submits that it appears that "the characteristic" is not replaced with a calculation value. Instead, it appears that "the data representative of a medically relevant characteristic" is replaced with a calculation value. The Examiner requests clarification of this issue.

(B) Similar analysis applies to claim 8.

(C) Claim 15 recites "wherein the measurement value is replaced with a calculation derived from one or more measurements." The Examiner respectfully submits that "the measurement value" lacks proper antecedent basis. For purposes of applying prior art, "the measurement value" is being interpreted as "the measurement."

(D) Claims 2, 4-7, 9, 11-14, 16, and 18-23 depend on claims 1, 8, and 15, and incorporate the deficiencies of those claims.

Claim Rejections - 35 USC § 103

Art Unit: 3626

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4-9, 11-14, 15-16, and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background of the Invention (pages 1-2 of Applicant's specification) in view of Coli et al. (6,018,713).

(A) As per claims 1, 8, 15, and 23, Applicant's Background of the Invention discloses that "It is known to automate medical report generation through the use of a computer. In the various report automation devices, various medical conditions can be selected from a list of medical conditions. The medical conditions represent clinical diagnoses and other information relevant to the exam. The medical conditions can also represent the underlying pathology that might be encountered." (It is noted this disclosure reads on "electronically selecting a medical condition for inclusion in a medical report; see pg. 1, par. 4 of specification). Applicant also discloses that "Another known report generation system feature enables the entry of measurement values into the report generation system such that various measurements pertaining to a patient's medical condition may be automatically inserted into a report." (It is noted this disclosure reads on "automatically inserting a measurement corresponding to the selected medical condition when the medical report is generated; see pg. 2, par. 6 of specification).

As per the newly amended features of “wherein the characteristic is replaced with a calculation value derived from one or more measurements,” “wherein the medical characteristic is replaced with a calculation value derived from one or more measurements,” and “wherein the measurement value is replaced with a calculation derived from one or more measurements.” The Examiner respectfully submits that Applicant’s Background of the Invention discloses at paragraph 6 that measurements may be derived by the report generation system from other use input, such as indicating points on a medical image between which distance or other metrics may be calculated. The Examiner interprets this disclosure to be a teaching of the feature of a calculation value derived from one or more measurements.

Thus, the only features that Applicant’s Background of the Invention fails to disclose is the feature of “the measurement replacing the field” or the characteristic being replaced with a calculation value and the features of “wherein the means for providing and the means for inserting comprise a computer readable medium downloaded for processing by a general purpose computer, a personal computer, or a specialized report generator” and computer instructions stored on a medium downloaded for processing by a general purpose computer to carry out the method.

Coli discloses a plurality of test results obtained through a plurality of types of tests used to make a diagnosis, where the test results are organized in a standardized format in which the test result values are arranged in predetermined fields. (Fig. 11-13, 18, 20, col. 13 line 43 to col. 14 line 67). Coli teaches that the test result values as shown in Fig. 18 and 20 are placed in a field associated with that type of test used to

Art Unit: 3626

make a particular patient diagnosis (reads on “fields representative of a plurality of medical conditions”) (col. 3 lines 43-52). Coli further teaches a graphically user interface for data input, wherein the reports of test results are generated using software running on client and server computers (see Fig. 11, col. 9 lines 4-60). Coli discloses the software environment further including a data management, storage, and retrieval application that organizes the information exchanged between hospitals, laboratories and insurance carriers, wherein this information is organized and stored within the environment of the operating system on one or more mass storage devices, wherein the software architecture underlying the particular preferred embodiment is based upon the hypertext conventions of the World Wide Web, wherein the computers can download hypertext pages (Fig. 1, col. 9 line 4 to col. 10 line 18).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Coli within Applicant's Background of the Invention with the motivation of providing reports in an easy-to-understand manner when reporting the results (Coli; col. 2 lines 52-64).

(B) As per claim 16, Coli discloses listing a plurality of defined values associated with the test results (see Fig. 11-13, 18, and 20; col. 13 line 43 to col. 14 line 67).

(C) As per claim 18, Coli discloses measuring the time and date of a test result (col. 14 lines 26-41).

Art Unit: 3626

(D) As per claim 19, Coli discloses updating the patient's test results when the report is requested through the automated test equipment interface, wherein the updated test results are directly put into a patient record which is then displayed as a patient report (col. 15 line 30 to col. 16 line 8).

(E) As per claim 20, Applicant's Background of the Invention discloses the medical condition being a clinical diagnosis (par. 4).

(F) As per claims 21-22, Coli discloses the test results being retrieved from a database (col. 14 lines 1-41).

(G) Claims 2, 4-7, 9, 11-14 repeat the subject matter of claims 15-16 and 17-21, and are therefore rejected for the same reasons as those claims.

Response to Arguments

8. Applicant's arguments filed 16 August 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed on 16 August 2006.

(A) At pages 11-17 of the response filed 16 August 2006, Applicant argues that the applied prior art fails to teach Applicant's claimed invention.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 16 August 2006 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Applicant's Background of the Invention and Coli, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action, and incorporated herein.

It is noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-

Art Unit: 3626

6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Art Unit: 3626

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

A handwritten signature in cursive script, appearing to read "Carolyn M. Bleck".

Carolyn M. Bleck

Patent Examiner

Art Unit 3626